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| 10/687,502      | 10/15/2003  | Cropper S. Michael   | END5008USCIP1       | 9047             |

27777 7590 08/14/2008  
PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

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| EXAMINER |
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ANDERSON, MICHAEL J

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| ART UNIT | PAPER NUMBER |
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3767

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08/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |  |                                       |  |
|------------------------------|--|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/687,502   | <b>Applicant(s)</b><br>MICHAEL ET AL. |  |
|                              | <b>Examiner</b><br>MICHAEL J. ANDERSON | <b>Art Unit</b><br>3767               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008 and 10 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Haber (US Patent No. 5,385,552).

With regards to new claims 25, Haber discloses (figures 2 and 5A) a surgical access device (2), comprising a seal assembly (124, 136) having a plurality of separate semicircular seal segments arranged in a conical shape, each seal segment having a circumference greater than 180 degrees and being adapted to seal against objects positioned through the seal.

With regards to new claims 26, Haber discloses (figures 2 and 5A) the surgical access device of claim 25 wherein said seal assembly has an outer perimeter which is attached to a flotation means (134).

With regards to new claims 27, Haber discloses (figures 2 and 5A) the surgical access device of claim 25 wherein said seal assembly includes a plurality of protectors (46, 98) disposed proximal to said elastomeric seal.

With regards to new claims 28, Haber discloses (figures 2 and 5A) the surgical access device of claim 25 wherein said layered elastomeric members are disposed such that there is a substantially centrally located aperture in said seal assembly.

With regards to new claims 29, Haber discloses (figures 2 and 5A) the surgical access device of claim 25, further comprising a cannula (14).

With regards to new claims 30, Haber discloses (figures 2 and 5A) a trocar for performing a procedure on a patient, said trocar comprising: a. a hollow cannula (14) having a distal end and a proximal end; b. a housing (58) having a distal end attached to said proximal end of said cannula and a proximal end having a wall (58) attached thereto, said wall having an aperture (64) therethrough; c. a seal assembly disposed within said housing comprising a first substantially rigid ring (132), a second substantially rigid ring (134), and a plurality of semicircular elastomeric members (124) compressed therebetween and forming a conical shape, the elastomeric members circumscribing an aperture in an interwoven pattern and cooperate to seal against objects positioned within the aperture.

With regards to new claims 31, Haber discloses (figures 2 and 5A) the trocar according to claim 30 wherein said elastomeric members comprise a proximal flange portion, and an inwardly extending portion extending distally therefrom, wherein said proximal flange portions are disposed between and are abutting against said rings (figure 2).

With regards to new claims 32, Haber discloses (figures 2 and 5A) the trocar according to claim 30 wherein said plurality of elastomeric layers are interwoven.

With regards to new claims 33, Haber discloses (figures 2 and 5A) the trocar according to claim 30 wherein said plurality of elastomeric members have a non-planar shape prior to be assembled together.

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With regards to new claims 34, Haber discloses (figures 2 and 5A) a trocar for performing a procedure on a patient, said trocar comprising: a. a hollow cannula having a distal end and a proximal end; b. a housing having a distal end attached to said proximal end of said cannula and a proximal end having a wall attached thereto, said wall having an aperture therethrough; c. an instrument seal assembly disposed within said housing comprising a plurality layered elastomeric members arranged circumferentially about an aperture in an alternating over and under pattern and forming a conical shape, the plurality layered elastomeric members cooperating to seal against instruments positioned through the aperture.

With regards to new claims 35, Haber discloses (figures 2 and 5A) the seal of claim 34, wherein the elastomeric members are semicircular.

With regards to new claims 36, Haber discloses (figures 2 and 5A) the seal of claim 35, wherein the elastomeric members have a circumference between 180 to 270 degrees.

With regards to new claims 37, Haber discloses (figures 2 and 5A) the seal of claim 34, wherein the instrument seal assembly further provides zero- closure (136).

With regards to new claims 38, Haber discloses (figures 2 and 5A) the seal of claim 34, wherein the elastomeric members are arranged in non- planar shape.

With regards to new claims 39, Haber discloses (figures 2 and 5A) the seal of claim 34, wherein the instrument seal assembly comprises four elastomeric members (124 a-d).

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With regards to new claims 40, Haber discloses (figures 2 and 5A) the seal of claim 34, further comprising a first substantially rigid ring and a second substantially rigid ring, the elastomeric members being compressed therebetween.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 25-40 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-32 of copending Application No. 10/815356. Although the conflicting claims are not identical, they are not patentably distinct from each other because all claim the trocar device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Amendment***

The present communication responds to the Amendment of 12/10/2007 and 7/17/2008. By these communications, claims 1-24 were cancelled and new claims 25-40 were added. The amendments did not add new matter. Claims 25-40 are pending. The rejection(s) are as stated.

***Response to Arguments***

Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. ANDERSON whose telephone number is (571)272-2764. The examiner can normally be reached on M-F 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin C. Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Anderson/  
Examiner  
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MJA

8/10/2008

/Kevin C. Sirmons/

Supervisory Patent Examiner, Art Unit 3767